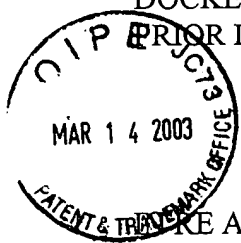


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RE APPLICATION OF:
MICHAEL C. SCROGGIE ET AL.

:

: GROUP: 3622

APPLICATION NUMBER: 09/401,939

: EXAMINER: GRAVINI, S

FILED: September 23, 1999

:

FOR: SYSTEM AND METHOD FOR PROVIDING SHOPPING AIDS AND INCENTIVES
TO CUSTOMERS THROUGH A COMPUTER NETWORK

37 CFR 1.192 APPEAL BRIEF

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

Sir: In response to the final office action mailed November 22, 2002, the applicants appeal.

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I. **37 CFR 1.192(a)**

This brief is filed in triplicate, is accompanied by the fee set forth in 37 CFR 1.17(c), and sets forth the authorities and arguments on which the appellant will rely to maintain the appeal.

II. **37 CFR 1.192(b)**

The filing is timely. Accordingly, this subsection is not relevant.

III. **37 CFR 1.192(c)**

A. **37 CFR 1.192(c)(1) - Real Party in Interest**

The real party in interest is Catalina Marketing International, Inc., a Delaware corporation, which is wholly owned by Catalina Marketing Corporation, a Florida corporation.

B. **37 CFR 1.192(c)(2) - Related Appeals and Interferences**

Appeals or related are pending in the following related applications:

1. US Application No.: 09/716,404 (Neifeld Ref.: CAT/29US-SCROCO4).
2. US Application No.: 09/401,198 (Neifeld Ref.: CAT/29US-SCROD1).

The applicants filed a reply brief July 1, 2002. The examiner sent applicants an acknowledgment of reply brief and forwarded the application to the Board of Patent Appeals and Interferences for decision on the appeal.

3. US Application No.: 09/410,086 (Neifeld Ref.: CAT/29US-SCROD2).

The applicants filed an appeal brief that was received by the USPTO on November 14, 2002.

4. US Application No.: 09/567,274 (Neifeld Ref.: CAT/29-SCROCO3). The USPTO mailed a non-final office action on November 6, 2002, the applicants have until February 6, 2003 to respond, and the applicants intend to appeal.

5. US Application No.: 90/005,888 (Neifeld Ref.: SCROREEX634) is a reexamination. The USPTO mailed a non-final third office action on May 14, 2002 and an office communication on August 16, 2002. The applicants filed remarks in response to notice re defective paper in ex parte reexamination that was received by the USPTO on August 30, 2002.

C. **37 CFR 1.192(c)(3) - Status of Claims**

Claims 1-31 were cancelled.

Claims 32-70 are pending, rejected, and under appeal.

D. 37 CFR 1.192(c)(4) - Status of Amendments

All amendments are entered.

E. 37 CFR 1.192(c)(5) - Summary of the Claimed Inventions

The claimed inventions provide a computer implemented system, method (claims 32 and 45) and computer program product (claim 58) for distributing purchasing incentives to consumers including (1) transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network (page 1 lines 27-30 and page 9 lines 6-8), displaying said plurality of product discounts at said personal computer based on said promotion data (page 8 line 28 through page 9 line 9), transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network (page 2 lines 7-8), generating token data depending on said selection data (page 19 lines 1-7), transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified retailer (page 1 lines 29-30 and page 2 lines 9-13).

The claimed inventions provides means for transmitting said token data from said main computer to said personal computer over said computer network (page 18 line 21 through page 19 line 7), identifying said token data in a retail store in association with items being purchased at said retail store (page 19 lines 8-12), determining discount items being purchased corresponding to said at least one product discount from said identified token data (page 19 lines 1-12), and generating a purchase incentive based on said discount items (page 16 lines 6-15).

The claimed inventions also provide computer implemented systems and methods (dependent claims 33-44, 46-57 and 59-70) for generating said purchase incentive comprises generating an instantly redeemable voucher (page 24 lines 21-28), generating said purchase incentive comprises generating a voucher that is redeemable on a subsequent visit to said retail store (page 24 lines 21-28), generating a shopping list based on said selected product discounts (page 14 lines 13-21), transmitting said shopping list from said main computer to said personal computer over said computer network (page 9 lines 10-17), transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified product manufacturer (page 18 lines 21-30), transmitting said promotion data

comprises transmitting promotion data identifying a plurality of product discounts from a specified product manufacturer and from a specified product retailer (page 18 lines 21-30), transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of demographic data stored in a personal database of a consumer (page 21 lines 14-21), transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of a frequency of usage of tokens by a consumer (page 20 lines 17-24), transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of a frequency of usage of product discounts by a consumer (page 20 lines 17-24), identifying said token data comprises identifying said token data by scanning a token having said token data therein (page 24 lines 21-26), said computer network comprises one of an intranet and the Internet (page 16 line 7 and Fig. 13, item 300).

F. 37 CFR 1.192(c)(6) - Issues

1. Whether the rejections of claims 32-70, under 35 USC 112, first paragraph, should be reversed.
2. Whether the rejections of claims 32-70, under 35 USC 102(b), as being clearly anticipated by any one of Von Kohorn (US 5,128,752), Ferguson et al. (US 5,256,863), Deaton et al. (US 5,430,644), or Day et al. (US 5,857,175), should be reversed.
3. Whether the rejections of claims 32-70 under 35 USC 103(a) as being unpatentable over an obvious variation of examiner's declared personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike.com should be reversed.
4. Whether the rejections of claims 32-70, under the judicially created doctrine of obviousness-type double patenting, over claims 1-3 of US Patent No. 5,970,469 or claims 1-10 of US Patent No. 6,185,541 should be reversed.

G. 37 CFR 1.192(c)(7) - Grouping of Claims

The claims do not stand or fall together. Each claim defines a separate group and stands or falls on its own.

H. **37 CFR 1.192(c)(8) - Argument**

1. **37 CFR 1.192(c)(8)(i) - First Paragraph 35 USC 112**

The examiner rejects claims 32-70 under 35 USC 112, first paragraph, stating that:

Claims 32-70 are rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention and in the alternative, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The independently claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data are not enabled by the specification, because the specification does not discuss transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data. Since the specification does not discuss these critical independently claimed elements in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claimed features are not enabled by the specification because examiner considers them to be concepts that cannot be practically applied to any embodiment of the invention such that those skilled in the art could make or use the invention. The specification merely recites vague language used in the claims and does not teach elements that one skilled in the art would need to make or use the invention. Since claims 33-44, 46-57, and 59-70 depend upon claim 32, 45, and 58 which recite the independently claimed non-enabling feature, those claims are also rejected as being non-enabling from the independent parent claim. In order to consider those claims in light of the prior art, examiner will assume that those claims contain enabling subject matter. [Office action mailed 11/22/02 page 4 line 5 through page 5 line 7.]

In reply, the applicants point out that there is almost *ipsus verbis* support for the subject claim recitations in the specification, and that the claimed limitations are clearly supported. Therefore, the rejections of claims 32-70 for lack of a written description are improper and should be reversed.

With respect to the examiner's assertion that "the specification does not discuss

transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network,” the applicants respectfully submits that page 9 lines 4-9 of the specification clearly discloses a consumer selecting coupon offers out of a plurality of offers after log-in and switching to offer browser. Page 9 lines 4-9 of the specification read as follows:

Basically, the offer browser 22 receives offer data from the manufacturers 14 on a periodic basis, and displays the offers to consumers 10 who have logged in to the system. The offer and sub-offer structure permits consumers to select coupon offers, rebate offers, or information offers made available by the manufacturers. Selected offers are accumulated in a session record maintained for the time that each consumer is logged in to the system.

Independent Claims 32, 45, and 58 define a selection limitation. Therefore, the rejections of these claims for lack of support is improper and should be reversed.

With respect to the examiner’s assertion that the specification does not support “generating token data depending on selection data,” the applicants respectfully submits that page 24 lines 2-6 of the specification clearly discloses that a server transmits token images defining coupon offerings to the user and depending coupons on selection data. Page 24 lines 2-6 of the specification read as follows:

Generating a “token” instead of coupon, as described above with reference to FIG. 13, also reduces the risk of fraud. Another technique similar to this is depicted in FIG. 18. A token 316 is generated by the user’s computer 302 after interaction with the distribution server 300. The user chooses from incentive offers as described above, but instead of a coupon the computer 302 generates the token 316.

Independent Claims 32, 45, and 58 define a token data based upon selection data limitation. Therefore, the rejections of these claims for lack of support is improper and should be reversed.

With respect to the examiner’s assertion that “[the] specification merely recites the same language used in the claims and does not teach elements that one skilled in the art would need to make or use the invention,” the applicants respectfully submits that this assertion is incorrect. In the specification of the present application, various examples are given in many paragraphs to

support the limitations discussed above. Some of these paragraphs read as follows:

The shopping list maker is entered, as indicated in block 220, from the main menu, or from any of various other screens. *The user may select a store department (block 222), such as meat, produce, and so forth, then select from displayed items sold in that department, as indicated in block 224. The selected items are added to the session record, as indicated in block 226, before a return is made to the main menu, as indicated in block 228. Items may be selected for adding to the shopping list whether or not any of the items is subject to a manufacturers' or supermarket special offer. Optionally, manufacturer and retailer offers may be displayed in the appropriate sections to alert the user of specials available. [Page 14 lines 13-21; emphasis supplied.]*

FIG. 10 shows the principal functions performed when the user enters the final list generation phase, as indicated in block 250. The system builds the final list, as indicated in block 252, *using the session record that has accumulated items selected by the user, as indicated in block 254. The final list is displayed to the user, as indicated in block 256, and the user may then exit to the main menu (block 258) or go to an exit page (block 260), which may have links to other shopper savings opportunities. The final list generation phase also contains hyperlinks to sites established by individual manufacturers and retailers. Finally, the system displays a "thank you" message and ends the session, as indicated in block 262. [Page 15 lines 13-21; emphasis supplied.]*

The applicants respectfully submit that all claimed limitations are disclosed in the specification. Moreover, the examiner's assertion that the claim limitations are not enabled is without factual basis. It was well known as of the date of invention how to program web sites to provide the data input and output functionality. Thus, these rejections should be reversed.

2. 37 CFR 1.192(c)(8)(ii) - Second Paragraph 35 USC 112

The examiner rejected claims 32-70 under 35 USC 112, second paragraph, stating that:

Claims 32-70 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independently claimed steps of transmitting selection data designating at least one product discount selected from a plurality of product discounts from a personal computer to a main computer over a computer network and generating token data depending on selection data fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because the specification does not provide an antecedent basis of transmitting selected data or generating token data. Since the specification does not provide an antecedent basis for these critical

independently claimed steps, the independently claimed invention is not described in the specifications such that it fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Since claims 33-44, 46-57, and 59-70 depend upon claim 32, 45, and 58 which recite the independently claimed indefinite feature, those claims are also rejected as being indefinite from the independent parent claim. In order to consider those claims in light of the prior art, examiner will assume that those claims contain non-indefinite subject matter. [Office action mailed 11/22/02 page 5 line 9 through page 6 line 3.]

In reply, the applicants first point out that there is almost *ipsus verbis* antecedent basis support for the subject claim recitations in the specification. See page 9 lines 10-21, page 14 lines 13-21, page 15 lines 13-21, and page 19 lines 8-12. Thus, the claimed recitations are supported.

Second, the second paragraph of 35 USC 112 is directed to the claims, not to the specification. Therefore, the examiner's assertion that "the specification does not provide an antecedent basis of transmitting selected data or generating token data" is not a basis to reject the claims under the second paragraph of 35 USC 112. Therefore, there is no factual assertion supporting the indefiniteness rejections. In summary, since the rejected claims are canceled and there is no basis for the rejections, the rejections are improper and should be reversed.

The examiner replied to the applicants' arguments in the office action dated November 22, 2002, as follows:

Applicant's arguments filed October 23, 2002 have been fully considered but they are not persuasive.

enablement, new matter, indefiniteness rejections

Applicants argue that the specification page 9 lines 4-9 overcomes the non-enabling and alternatively new matter feature of transmitting selection data because it clearly discloses a consumer selecting coupon offers out of a plurality of offers. That portion of the specification merely discusses a consumer offer display from a manufacturer and accumulation thereof and is silent with respect to the claimed "discount selected from a personal computer to a main computer over a computer network." Nothing in applicants response or specification addresses this claimed feature expressly or implicitly and additionally shows that the claimed feature is new matter reinforcing the enablement rejection.

Applicants also argue that the specification page 24 lines 2-6 overcomes the non-enabling feature of generating [token] data depending on selection data

because a server transmits token images defining coupon offerings to the user. The recited "depending on said selection data" in that claimed feature is not discussed implicitly or expressly in the cited or any part of the specification. Applicants have not addressed the nexus of the claimed token data generation dependent upon selection data.

Applicants comment regarding the specification and the claim language is noted and the rejection has been modified to more accurately address the enablement features. However, the cited specification does not provide enablement for the claimed features discussed supra. Applicants are correct in the rejection of claims 32-70 instead of the examiner's typographical error in stating claims 1-20 and that error has been remedied. However examiner must look to the specification in interpreting the claims, and since the claims fail to particularly point out and distinctly claim the subject matter of the invention, it is proper to reject those claims based on an improper antecedent basis from the specification. Please see MPEP 608.01(g) and 37 CFR 1.75(d)(1) since the scope of the [claim] is indeterminate. [See office action mailed 11/22/02 page 12 line 3 through page 13 line 6.]

In reply, the applicants first point out that the examiner's assertions (1) that the specification of page 9 lines 4-9 does not disclose the subject matter of a "discount selected from a personal computer to a main computer over a computer network" is a different basis for rejection than he previously stated.

Notwithstanding the change in rationale for the rejections, the applicant points out that the specification also discloses transmitting of the selection data designating at least one product discount from said personal computer to said main computer. For example, page 4 lines 9-10 state that the invention includes a method of distributing incentives over a communication network including the step of "selecting at the customer site one or more of the incentive offers and transmitting these selections back to the central site." The word "customer site" refers to the computer of the network as shown for example by "user pc" 302. Likewise the claimed "central site" refers for example to "server" 300 in system Figure 13. Moreover, the specification discloses at page 20 lines 2-3 states that the "incentive is transmitted to the customer, as indicated in block 416, in the form of an Internet message." Also see page 8 lines 29-30 of the specification, which state that "[the] system provides a unique communication network

connecting consumers, indicated at block 10, retailers 12 and manufacturers 14.” Also see page 9 lines 16-17, which state that “any coupon offers or rebate offers associated with any of the ingredients are also automatically included in the final list to be transmitted to the consumer.” Thus, the specification does disclose the computers and the transmission of incentive selection data. Independent claims 32, 45, and 58 define transmission of selection data from a PC to a server computer. Therefore, the rejections of these claims for indefiniteness or lack of support are improper and should be reversed.

The examiner’s assertion that applicants have not addressed [sic; the specification does not disclose] the nexus of the claimed token data generation dependent upon selection data” is not correct. The examiner does not define to which claims his argument relates. The applicants assume that the examiner’s argument relates to the recitation in claim 32 of “generating token data depending on said selection data.” That recitation is supported for example by the recitation in original claim 29 of “in response to the consumer selections, generating a token and transmitting it to the consumer’s remote terminal.” Moreover, the specification page 24 lines 5-6 contains similar disclosure. Thus, the specification does disclose generating token data based upon selection data, as claimed. Independent claims 32, 45, and 58 define generating token data depending upon selection data. Therefore, the rejections of these claims for lack of support are improper and should be reversed.

The examiner's arguments do not relate to recitations in the dependent claims. Therefore, the rejections of these claims are improper and should be reversed for the reasons applicable to the independent claims.

For all of the foregoing reasons, the rejections of claims 32-70 based upon 35 USC 112 are improper and should be reversed.

3. 37 CFR 1.192(c)(8)(iii) - 35 USC 102

The examiner rejected claims 32-70 under 35 USC 102(b), stating that:

Claims 32-70 are rejected under 35 USC 102(b) as being clearly anticipated by von Kohorn (US 5,128,752), Ferguson et al. (US 5,256,863), Deaton et al. (US

5,430,644), or Day et al. (US 5,857,175). [Office action mailed 11/22/02 page 6 lines 6-8.]

In reply, the applicants respectfully traverse these rejections because they are not supported by substantial evidence, and because the examiner provides no explanation or analysis supporting his conclusions.

a. **Day et al.**

Moreover, Day et al. (US 5,857,175), Von Kohorn (US 5,128,752), Ferguson et al. (US 5,256,863) and Deaton et al. (US 5,430,644) do not anticipate the subject matter defined by claims 32-70.

Day discloses a system for providing discounts at the check-outs in a particular store. In contrast, claim 32 defines a system that “transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network,” and then “generating token data depending on said selection data.” Therefore, this reference does not anticipate claim 32, or any of claims 33-70 for at least the same reasons.

Moreover, Day does not disclose and claim 32 defines a system that “[transmits] selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network,” and later “transmitting said token data from said main computer to said personal computer over said computer network.” Therefore, this reference does not anticipate claim 32, or any of claims 33-70 for at least the same reasons.

Moreover, Day does not disclose and claim 32 defines a system that “[transmits] said token data from said main computer to said personal computer over said computer network; identifying said token data in a retail store in association with items being purchased at said retail store; generating a purchase incentive based on said discount items.” Therefore, this reference does not anticipate claim 32, or any of claims 33-70 for at least the same reasons.

Moreover, each one of claims 33-70 defines additional limitations. The examiner does not explain why any of those limitations are anticipated by the cited reference. Accordingly, the limitations defined by each one of those claims provides an additional reason why each one of

those claims is not anticipated by the cited reference.

b. Von Kohorn

Von Kohorn discloses a system that transmits and displays product information in a viewer's home. In the system disclosed by Von Kohorn, tokens and coupons are generated in a home generating unit after the viewer entering selected product information.

Von Kohorn does not disclose an on line distribution of purchase incentives. In contrast, claim 32 defines a system "transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network."

Moreover, Von Kohorn does not disclose either a two-way system interactive with the end users or a system interacting with the retailers. In contrast, claim 32 defines a method interacting with both the end users and the retailers via selection of incentives and generation of tokens. Therefore, Von Kohorn does not anticipate either claim 32 or any one of claims 33-70 for at least the same reasons.

Moreover, each one of claims 33-70 defines additional limitations. The examiner does not explain why any of those limitations are anticipated by the cited reference. Accordingly, the limitations defined by each one of those claims provides an additional reason why each one of those claims is not anticipated by the cited reference.

c. Deaton

Deaton discloses automatic check reading techniques that enable the detection of a customer's checking account number on a check.

Deaton does not disclose either on line distribution of incentives or distribution of tokens. In contrast, claim 32 defines a system that generates token data based upon incentive selection data and "[transmits] said token data from said main computer to said personal computer over said computer network." Therefore, this reference does not anticipate claim 32, or any of claims 33-70 for at least the same reasons.

Moreover, each one of claims 33-70 defines additional limitations. The examiner does not explain why any of those limitations are anticipated by the cited reference. Accordingly, the limitations defined by each one of those claims provides an additional reason why each one of those claims is not anticipated by the cited reference.

d. Ferguson

Ferguson discloses a system for automating data acquisition and processing at a check stand point-of-sale in a retail outlet. The abstract of Ferguson reads as follows:

Preferred embodiments include a first local area network of POS terminals for initiating merchandise purchase transactions. All of the purchase transactions in the first local area network are passively monitored to acquire primary purchase data. A second local area network of lane terminal devices inputs secondary data, including discount coupon information, check information and bank card information to a universal system controller. The universal system controller mirrors the primary information, processes the primary and the secondary information, and generates output information to the POS terminals of the first local area network via the lane terminal devices of the second local area network, the output information including coupon verification data, coupon amount data, check verification data and bank card verification data.

Ferguson does not disclose generating token data depending on selection data selected from a personal computer. In contrast, claim 32 defines a system that “generates token data depending on said selection data.” Therefore, this reference does not anticipate either claim 32 or any one of claims 33-70 for at least the same reasons.

Moreover, each one of claims 33-70 defines additional limitations. The examiner does not explain why any of those limitations are anticipated by the cited reference. Accordingly, the limitations defined by each one of those claims provides an additional reason why each one of those claims is not anticipated by the cited reference.

e. The Examiner's Reply Regarding Day, Von Kohorn, and Ferguson

With respect to the applicants reasons for traversing the 35 USC 102 rejections, the examiner replied in the November 22, 2002 office action, stating that:

Anticipatory rejections

Examiner has withdrawn the prior art rejections based on the applicants arguments that the references are not prior art but relies only the portion of the claims supported by the priority documents which can be properly rejected. Examiner will assume that the claims recite subject matter found in the priority documents but since the claims in the present application contain subject matter not supported by the specification, those enablement and indefiniteness rejections will be maintained.

Applicants argue that the claimed invention is not anticipated by any of the prior art used in the rejection above. The claimed invention is understood to be a method and system of transmitting promotion and selection data for personal computer display while

generating transmitting, and identifying token data in a retail store for discounted purchase from a main computer. In other words the invention as claimed communicates two different types of data between a main and personal computer with one of the types of data used to provide a basis for a third type of data.

Applicants argue that Day does not disclose the non enabling and indefinite features rejected above along with the claimed token data (one of two types of data) being transmitted back to the main from personal computer and retail store identification for generating a purchase incentive or third type of data. Applicants also argue that con Kohorn does not disclose an online distribution of data claimed as purchase incentives or a two-way interactive user retailer system. Applicants further argue that Deaton does not disclose the distribution of coupons or similar incentives. Applicants finally argue that Ferguson does not disclose generation of a third type of data or [token] data dependent upon one of two types of data between a main and personal computer with one of the types of data used to provide a basis for a third type of data. Each of the clearly anticipated references disclose the claimed invention on the face of each reference and examiner maintains the rejection based on applicants claimed invention and supporting arguments. [Office action dated 11/22/02 page 13 line 7 through page 14 line 13.]

In reply, the applicants respectfully point out that the foregoing statements do not provide any additional reasoning or assertions of fact in support of any rejection.

4. 37 CFR 1.192(c)(8)(iv) - 35 USC 103

The examiner rejected claims 32-70 under 35 USC 103(a) based upon his alleged personal knowledge, declaring that¹:

Claims 32-70 are rejected under 35 USC 103(a) as being unpatentable over an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike.com (hereinafter PerformanceBike). Since at least 1994, PerformanceBike has performed the claimed method, system, and program of:

transmitting promotion data identifying a plurality of product discounts from a main personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selections data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

¹The examiner gave a declaration reciting what is quoted here. See attachment 9, which is a copy of the declaration.

generating token data depending on said selection data;
transmitting said token data from said main computer to said personal computer over said computer network;
identifying said token data in a retail store in association with items being purchased at said retail store;
determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items. Examiner also has personal knowledge of instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification. The claimed promotion data transmission and product discount display occur when the examiner went into a PerformanceBike retail outlet store and viewed discounted products from a sales catalog. The selection data transmission occurs when the examiner uses the red courtesy phone (functionally equivalent to a claimed personal computer) and calls the retail outlet distribution center (functionally equivalent to the claimed main computer). The generating, transmitting, and identifying token data occurs when examiner's frequent buyer card bar code number is processed for the product selection data made from the red courtesy phone (examiner's frequent buyer card bar code number is the same as the claimed token data). The step of determining discount items being purchased occurs when the retail outlet distribution center verifies the final purchase order of the examiner. Generating purchase incentive based on discount items occurs when the examiner is credited with frequent buyer points rewarded for discount item purchased. The dependently claimed steps including instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification are also services and features available using PerformanceBike based on examiner's experience. The claimed invention, recited by the applicant, has been provided by PerformanceBike long before the filing of applicants' invention. Examiner takes Official notice that it is old and well known to those skilled in the art of distributing purchase incentives to consumers, that it would have been obvious to claim the invention as recited by the applicant, in order to overcome the explicit teachings of the published prior art. Furthermore examiner experience teaches the claimed invention except for the personal computer display. It would have been obvious to one skilled in the art to provide

a personal computer display since the computer display is merely an automated feature of a concept that is old and well known as discussed above. Please see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) in which the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art)[sinc]. The motivation to combine applicants claimed invention with the services offered by PerformanceBike in order is to allow advertisers greater consumer targeting capabilities, while transferring information, which clearly shows the obviousness of the claimed invention. [Office action mailed 11/22/02 page 6 line 11 through page 9 line 6.]

In reply, the applicants respectfully traverse these rejections because they are not supported by any substantial evidence, and because they fail to carry the burdens of proof and persuasion. The examiner alleges personal knowledge of the existence of the PerformanceBike.com web site of “[s]ince at least 1994.” This allegation, even though asserted now by the examiner in a declaration, fail to carry the burden of proof as to the existence of the PerformanceBike.com web site prior to the applicant's priority filing date, i.e., prima facie date of invention.

a. No Physical Evidence Supports the Examiner's Declaration

That applicant first points out that there is no physical evidence supporting the examiner's assertions that the Performancebike.com web site existed in 1994. In fact, the PerformanceBike.com website printout enclosed with the July 29, 2002 office action shows a copyright year of 2000, which is the prima facie date associated with that website. Accordingly, no physical evidence supports the examiner's assertion that any performancebike.com web site existed prior to the priority date for this application.

b. Probative Evidence Exists That The PerformanceBike.com Web Site Did Not Exist In 1994

Submitted with this Brief is probative physical evidence that the www.PerformanceBike.com web site did not exist until some time in 1997, and certainly no later than December of 1996.

i. The Web Master for PerformanceBike.com Indicated That the First PerformanceBike.com Web Site Was Launched in Late 1996

I spoke with the web master of performance bike on 9/19/02, via telephone. The web master is Andrew Ruggeri, telephone number 800-433-1633 (at an internal company extension of that number). Mr. Ruggeri clearly indicated to me (1) that he knew that the first web site for Performance Bike was launched in *August or September of 1996*, (2) that he became an employee of Performance Bike in 1997, and (3) that he knew that the Performance Bike web site has never provided coupons for retail store purchases. Mr. Ruggeri indicated that one reason the web site has never provided coupons for retail store purchases was that the pricing structure for web based sales and retail store sales were different, and therefore, placing incentives for retail store purchase on the website would be incompatible with the distinct pricing for web site sales and retail store sales.

I attempt to get a declaration from Mr. Andrew Ruggeri, but his company resisted my request, and referred me to their outside IP counsel, Christopher Bolen, Esq. Third party discover in not available for ex parte matters, and therefore I do not have the right to compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this brief with that such evidence, if and when it becomes available.

ii. **Physical Evidence Indicates That The
PerformanceBike.com Web Site Came into Existence in
Late 1997**

A ten-page printout at URL www.archive.org/about/about.php describing the WAYBACK MACHINE is submitted herewith.² A five page printout of the URL www.archive.org is submitted herewith.³ A two page printout of the URL pages.alexa.com/company/index.html?p=Dest_W_t_40_B1 is submitted herewith.⁴ As indicated in those attachments, www.archive.org is run by the "Internet Archive", which is a non profit library organization dedicated to archiving the Internet. The Internet Archive has been receiving

²A copy of the ten page printout of www.archive.org/about/about.php is attachment 1.

³A copy of the five page printout of www.archive.org is attachment 2.

⁴A copy of the two page printout of pages.alexa.com/company/index.html?p=Dest_W_t_40_B1 is attachment 3.

data regarding the web from "Alexa", which is a company that runs a 'web crawler.' A web crawler is a computer system that downloads and reviews all of the high level URLs for content on a periodic basis, for indexing their content for use by search engines.

The WAYBACK MACHINE is a web enabled interface between the Internet Archive's data store that enables anyone with a web browser to see what certain web sites looked like on prior dates. See attachment 2.

I used the WAYBACK MACHINE to see what versions of the PerformanceBike.com web site existed at prior dates. Specifically, I used the WAYBACK MACHINE's search function for <http://performancebike.com> on November 27, 2002. My results are attachment 4.⁵ The search result shows that PerformanceBike.com web site was not launched until October 1997. Specifically, attachment 4 states "no pages" in 1996, which means that the URL domain name was registered with the domain name register in 1996, but that no web pages were associated with the logical address www.PerformanceBike.com in 1996 that could be downloaded to a user's computer via use of a web browser. In contrast, attachment 4 shows web pages associated with www.PerformanceBike.com beginning October 17, 1997, and web pages continuously associated with that URL ever since. This means that the www.PerformanceBike.com web site, that is, a URL which would transmit web pages to a user, did not exist prior to the priority filing date for this application.

I attempted to get a declaration from a representative of the Internet Archive. However, their representative referred me to their counsel, which is Rachel Silvers of the firm of Perkins Coie LLP in San Francisco. Ms. Silvers indicated that the Internet Archive refused to provide a declaration explaining the meaning of the "1996 no pages" text in attachment 4. Third party discover is not available for ex parte matters, and therefore I do not have the right to compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this brief with that such evidence, if and when it becomes available.

iii. **The www.PerformanceBike.com Domain Name Was**

⁵A Copy of the printout of the WAYBACK MACHINE'S search result for <http://performancebike.com> conducted on November 27, 2002 is attachment 4.

Not Even Registered Until December 3, 1996

Network Solutions, Inc. was founded in 1979 and is located in Herndon, Virginia. Until recently, in 1999, Network Solutions, Inc. ("NSI") was the only registrar of domain names for the web. www.netsol.com is NSI's web site.⁶ It contains a WHOIS search engine.

This type of search engine provides users information related to a particular web site, such as registrant name, date of initial registration, and date of most recent update.

I conducted a search for www.PerformanceBike.com on the WHOIS search engine at www.netsol.com on December 2, 2002. A printout of the WHOIS search result for www.PerformanceBike.com from www.netsol.com WHOIS search engine is submitted herewith as attachment 7.⁷ The search result shows that the domain name www.PerformanceBike.com was not registered until December 3, 1996.

When a domain name is registered, it is by contract, controlled by the entity that purchased it. It does not automatically have web pages, i.e., a web site, associated with it. Therefore, the mere fact that www.PerformanceBike.com was registered on December 3, 1996, does not imply that a web site, i.e., content available for downloading to a user's browser, existed on that date. In fact, complicated web sites often take months to develop before they are ready for loading onto the web as a web site.

I attempted to get a declaration from a representative of NSI explaining that the date listed in their WHOIS search engine is the date that a domain name was first registered in the master Domain Name Service hosted by NSI and therefore the earliest date on which the domain name would have been available for hosting a web site.

A representative of NSI verbally indicated to me that NSI only accepted subpoena's for testimony via FAX, and that NSI did not respond to voluntary requests for discovery. Third party discover is not available for ex parte matters, and therefore I do not have the right to

⁶A copy of the printout from www.verisign.com/corporate/news/apr_19980107.html describing Network Solutions, Inc., is attachment 5. A copy of www.wired.com/news/politics/0,1238,31551,00.html is attachment 6.

⁷A copy of the printout from www.netsol.com's WHOIS search engine for www.PerformanceBike.com is attachment 7.

compel a declaration at this time. Since this evidence is currently unavailable to me, I reserve the right to supplement this brief with that such evidence, if and when it becomes available.

All of the above listed physical evidence is contradictory to the assertions provided in the examiner's declaration as to the date of existence of the PerformanceBike.com web site (i.e., in 1994), and to the assertion that the web site is legal prior art to claims in this application.

Furthermore, the examiner has made "blanket statements" in his declaration that each and every limitation claimed in claims 32-70 were known to him prior to December 1996. Those statements are not supported by any specificity. The examiner's blanket statements in his declaration that each and every limitation claimed in claims 32-70 were known to him prior to December 1996 - - almost a decade ago - - are objectively implausible. Moreover, the existence of such blanket statements without providing any specificity as to any specific time, place, and observations, objectively indicates a lack of consideration of the seriousness involved in giving a declaration subject to penalty of perjury. For the foregoing reasons, I submit that the existence of the blanket statements undermines the examiner's credibility as to any facts asserted in his declaration and specifically including the date of timewise availability of the performancebike.com web site.

In deciding whether the examiner has made a prima facie case as to timewise availability of the performancebike.com web site, the APJ's must compare the weight of the physical evidence indicating that the web site did not exist until 1997 to the examiner's unsupported recollection that the web site existed in 1994 -- almost a decade ago. I submit that the examiner's unsupported recollection is clearly outweighed by the weight of the physical evidence and the information Mr. Ruggieri passed along to me. Accordingly, the APJs should conclude that the burden of the evidence indicates that the performancebike.com web site is not timewise available as prior art.

iv. The PerformanceBike.com Web Site Did Not In Fact Anticipate Any One of Claims 32-70

The applicants point out that the PerformanceBike.com web site does not now and did not in 1997 distribute incentives for in-store use, contrary to the examiner's assertion. A copy of printouts of pages of the PerformanceBike web site obtained from the WAYBACK MACHINE's

archive of the www.performancebike.com web site for 1997 is attachment 8. Note the copyright date on the front page of attachment 8 is 1997. Attachment 8 shows a web site which has none of the functionality claimed in the pending claims. None of those pages disclose or appear to provide incentives for in store use.⁸ It is highly unreasonable to assume that performancebike.com launched a web site with advanced functionality that provided incentives for in-store use as defined in the pending claims prior to 1996, at the beginning of the World Wide Web, and then removed all of that functionality prior to 1997. Accordingly, there is highly probative evidence that the teachings upon which the examiner asserts existed in the performancebike.com web site did not exist prior to 1997, i.e., did not exist prior to the priority date for the claims in this application. For this additional reason, the rejections based upon the examiner's declaration should be reversed.

v. The Examiner's Assertions Are Contradictory and not Specific as to Observed Activity, Place, and Time

The examiner's assertions in support of the 35 USC 103 rejections in the office action dated November 22, 2002 are contradictory. The examiner asserts in his declaration that the PerformanceBike.com web site disclosed the claimed inventions, by stating that:

Since at least 1994, PerformanceBike has performed the claimed method, system, and program of:

transmitting promotion data identifying a plurality of product discounts from a main personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selections data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

⁸A copy of the printout of 8 pages of the PerformanceBike.com web site from 1997, as stored in the WAYBACK MACHINE is attachment 8.

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and
generating a purchase incentive based on said discount items. [Office action dated 11/22/02 page 6 line 13 through page 7 line 11.]

However, the examiner corresponds claimed limitations to non-web site structure in a retail store, including (1) an in-store red courtesy phone, (2) a frequent buyer card, and (3) discounts associated with products in the retail outlet store.

A red courtesy phone does not describe or suggest the claimed "displaying," or "main" or "personal" computer.

Ordering from a red courtesy phone does not disclose or suggest any one of the claimed steps of transmitting or selecting of incentives, or generation, transmission or use of tokens.

In contrast to an "in store red courtesy phone", a personal computer has a memory capable of computing and with digital input and output ability. The in store red courtesy phone is not a computer, has no memory, cannot download or upload digital data files, let alone print purchase incentives. Accordingly, a red courtesy phone does not correspond to the claimed personal computer.

Moreover, no claim limitations respond to the steps of a person going into a retail store and viewing discounted products from a sales catalog, using a frequent buyer card during a purchase, or using frequent buyer points. Therefore, the examiner's reliance upon the performancebike.com web site as suggesting the claimed invention is both inconsistent and logically improper. Thus, the examiner's assertions are irrelevant to the claimed invention. Therefore, the rejections that rely upon those assertions should be reversed.

Finally the examiner's assertions are not backed up by any specificity. No specific time, place, or event is alleged in the examiner's declaration. Specificity is an important factor in determining probative value of any statement. "The lack of specificity deprives the appellant of a suitable rebuttal and makes the rejection vague and uncertain on review. Absent sufficient findings, it cannot be said that the examiner has sufficiently made out a prima facie case of

obviousness.”*Ex parte Marckini* (Appeal No. 97-3671, Application 08/266,977 at <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd973671.pdf> at page 9) (not binding precedent). Furthermore, the examiner has the burden to establish a prima facie case of obviousness. The examiner is required to establish a factual basis to support obviousness conclusion. *In re Fine*, 837 F.2d 1071, ___, 5 USPQ 2d 1596, 1988. Since the examiner has not provided specificity as to time, place, and event of any relevant prior public use, and since the examiner has not provided a meaningful explanation of the allegedly relevant performancebike.com web site's teachings, the rejections should be reversed.

For all the foregoing reasons, the rejections based upon the examiner’s declaration are improper and should be reversed.

5. **37 CFR 1.192(c)(8)(v) - Other Rejections**

a. **The Rejection of Claims 32-70 under the Judicially Created Doctrine of Obviousness-type Double Patenting as Being Unpatentable over Claims 1-3 of Us Patent No. 5,970,469 or Claims 1-10 of Us Patent No. 6,185,541**

The examiner rejects claims 32-70 under the judicially created doctrine of obviousness-type double patenting, stating that:

Claims 32-70 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,970,469 or claims 1-10 of U.S. Patent No. 6,185,541. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claim of encoded [sic] (‘469 patent) is an obvious variation of the application claimed token [sic] and the patented claimed [sic] advisory message (‘541 patent) is an obvious variation of the application claimed general purchase incentive because both perform the same function in the same manner with the same result. [Office action mailed 11/22/02 page 9 line 9-15.]

In reply, the applicants traverse the rejections based upon US 5,970,469's claims. Those claims define transmitting purchase incentives associated with recipes, whereas the present claims define identifying token data in a retail store for generating purchase incentives. One would not have been obvious in view of the other. Therefore, the rejections based upon claims 1-3 in U.S. Patent No. 5,970,469 are improper and should be reversed.

The applicants also traverse the rejections based upon claims 1-3 in US 6,185,541. Those

claims define details of printing coupons by a user's computer, region data analysis, and transmission of terms of an incentive to an in-store server, whereas the claims in this application define identifying and generating token data for use in a retail store. One would not have been obvious in view of the other. Therefore, the rejections based upon claims 1-10 in in US 6,185,541 are improper and should be reversed.

With respect to the applicants reasons for traversing the double patenting rejections, the examiner replied in the November 22, 2002 office action, stating that:

Double patenting rejection

Both patents supporting the double patenting rejections are obvious variations of the claimed invention as discussed supra under that rejection. Applicants assert patent ability over those patents without patentably distinguishing the independent and distinct features. Both patents encompass the subject matter claimed in the present invention and therefore examiner maintains the double patenting rejection.

Applicants further assert the provisional double patenting rejection is improper because those applications do not qualify as prior art. However, both applications claim priority such that each may qualify as prior art. [Office action mailed 11-22-02 page 15 lines 1-9.]

In reply, the applicants point out that the examiner has provided no new reasons or facts in support of any rejection. Thus, all of the double patenting rejections should be reversed.

b. The Rejection of Claims 32-70 under 35 USC 103(a) as Being Obvious over Co-pending Applications

The examiner rejected claims 32-70 under 35 USC 103(a) as being obvious over co-pending applications, stating that:

Claims 32-70 are rejected under 35 U.S.C. 103(a) as being obvious over copending Application Nos. 09/478,351 or 09/567,274 or 09/716,404. Each application contains claims reciting obvious variation of the claimed method, system, and program of:

transmitting promotion data identifying a plurality of product discounts from a main personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;
transmitting said token data from said main computer to said personal computer over said computer network;
identifying said token data in a result store in association with items being purchased at said retail store;
determining discount items being purchased corresponding to said at least one product discount from said identified token data; and
generating a purchase incentive based on said discount items along with instant or subsequent redeemable vouchers, separate shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token use or product use frequency basis, and internet/intranet token scanning identification.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(1)(1) and § 706.02(1)(2). [Office action mailed 11/22/02 page 9 line 17 through page 11 line 14.]

In reply, the applicants traverse these rejections at least because the applications relied upon do not qualify as prior art (1) because 09/478,351 was filed 5/9/02, (2) 09/567,274 appears from the PTO website to be unpublished, and (3) 09/716,404 appears from the PTO website to be unpublished.

I. 37 CFR 1.192(c)(9) - Appendix

Appendix I contains a clean copy of claims 32-70 under appeal.

IV. Groupings of Claims

Each claim defines a separate group for at least the following reasons. Each claim defines

a different set of limitations. Each such limitation defines a different reason why that claim is not anticipated by any one of Day, Ferguson, Von Kohorn, and the examiner's personal knowledge.

V. 37 CFR 1.192(d) - Non-compliant Brief

This brief is in compliance with 37 CFR 1.192(c). Accordingly, this subsection is inapplicable.

VI. Response to Examiner's Request under 37 CFR 1.105

The examiner requested prior art papers used in preparing this application. I have inquired with (1) Catalina Law Department (for the Assignee), (2) Mike Scroggie (the first named inventor), and (3) Noel Heal (the attorney who drafted the application). All of those entities reported to me that they had no readily available files relating to this request, and none of them recall any prior art document used in preparing the application. I personally know of no prior art used in preparing this application.

VII. Response to Request to Cite Relevant References

I do not know of any references more relevant than those already cited by the examiner in this or the related cases. I do regret the volume of prior art forced into this application due to litigation involving a patent issued from a related application.

VIII. Appendix II

Appendix II contains a list of attachments that are cited as evidence in this brief.



31518

PATENT TRADEMARK
OFFICE

Date

3/11/03

Respectfully Submitted,

Richard A. Neifeld, Ph.D.
Registration No. 35,299
Ruay Lian Ho
Registration No. 48,110

Printed: March 13, 2003

Y:\Clients\Catalina\CAT29US-SCRO\CAT29US-SCROCO\Draft\AppealBrief_021122.wpd

IX. Appendix I - 37 CFR 1.192(c)(9) Claims Under Appeal

Claims 32-70 are pending and subject to this appeal.

32. (Once Amended) A computer implemented method for distributing purchasing incentives to consumers, comprising:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items.

33. (Once Amended) The method of claim 32, wherein generating said purchase incentive comprises generating an instantly redeemable voucher.

34. (Once Amended) The method of claim 32, wherein generating said purchase incentive comprises generating a voucher that is redeemable on a subsequent visit to said retail store.

35. The method of claim 32, further comprising generating a shopping list based on said selected product discounts.

36. The method of claim 35, further comprising transmitting said shopping list from said main computer to said personal computer over said computer network.

37. (Once Amended) The method of claim 32, wherein transmitting said promotion data

comprises transmitting promotion data identifying a plurality of product discounts from a specified product manufacturer.

38. (Once Amended) The method of claim 32, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified retailer.

39. (Once Amended) The method of claim 32, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified product manufacturer and from a specified product retailer.

40. (Once Amended) The method of claim 32, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of demographic data stored in a personal database of a consumer.

41. (Once Amended) The method of claim 32, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of a frequency of usage of tokens by a consumer.

42. (Once Amended) The method of claim 32, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of a frequency of usage of product discounts by a consumer.

43. (Once Amended) The method of claim 32, wherein identifying said token data comprises identifying said token data by scanning a token having said token data therein.

44. The method of claim 32, wherein said computer network comprises one of an intranet and the Internet.

45. A system for distributing purchasing incentives to consumers, comprising:

a computer network;

at least one personal computer;

a main computer coupled to said at least one personal computer via said computer network and configured to transmit promotion data identifying a plurality of product discounts to said at least one personal computer over said computer network;

said at least one personal computer configured to display said plurality of product discounts based on said promotion data;

said at least one personal computer configured to transmit selection data designating at least one product discount selected from said plurality of product discounts to said main computer over said computer network;

said main computer configured to generate token data depending on said selection data;

said main computer configured to transmit said token data to said at least one personal computer over said computer network;

a retail store configured to identify said token data in association with items being purchased at said retail store;

said retail store configured to determine discount items being purchased corresponding to said at least one product discount from said identified token data; and

said retail store configured to generate a purchase incentive based on said discount items.

46. The system of claim 45, wherein said retail store is configured to generate an instantly redeemable voucher as said purchase incentive.

47. The system of claim 45, wherein said retail store is configured to generate a voucher that is redeemable on a subsequent visit to said retail store as said purchase incentive.

48. The system of claim 45, wherein said main computer is configured to generate a shopping list based on said selected product discounts.

49. The system of claim 48, wherein said main computer is configured to transmit said shopping list to said at least one personal computer over said computer network.

50. The system of claim 45, wherein said main computer is configured to transmit promotion data identifying a plurality of product discounts from a specified product manufacturer.

51. The system of claim 45, wherein said main computer is configured to transmit promotion data identifying a plurality of product discounts from a specified retailer.

52. The system of claim 45, wherein said main computer is configured to transmit promotion data identifying a plurality of product discounts from a specified product manufacturer and a specified product retailer.

53. The system of claim 45, wherein said main computer is configured to transmit

promotion data identifying a plurality of product discounts based on demographic data stored in a personal database of a consumer.

54. The system of claim 45, wherein said main computer is configured to transmit promotion data identifying a plurality of product discounts based on a frequency of usage of tokens by a consumer.

55. The system of claim 45, wherein said main computer is configured to transmit promotion data identifying a plurality of product discounts based on a frequency of usage of product discounts by a consumer.

56. The system of claim 45, wherein said retail store is configured to identify said token data by scanning a token having said token data therein.

57. The system of claim 45, wherein said computer network comprises one of an intranet and the Internet.

58. (Once Amended) A computer program product comprising a computer storage medium having a computer program therein for distributing purchasing incentives to consumers, said computer program performing:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items.

59. (Once Amended) The computer program product of claim 58, wherein generating said purchase incentive comprises generating an instantly redeemable voucher.

60. (Once Amended) The computer program product of claim 58, wherein generating said purchase incentive comprises generating a voucher that is redeemable on a subsequent visit to said retail store.

61. The computer program product of claim 58, further comprising generating a shopping list based on said selected product discounts.

62. The computer program product of claim 58, further comprising transmitting said shopping list from said main computer to said personal computer over said computer network.

63. (Once Amended) The computer program product of claim 58, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified product manufacturer.

64. (Once Amended) The computer program product of claim 58, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified retailer.

65. (Once Amended) The computer program product of claim 58, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified product manufacturer and from a specified product retailer.

66. (Once Amended) The computer program product of claim 58, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of demographic data stored in a personal database of a consumer.

67. (Once Amended) The computer program product of claim 58, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of a frequency of usage of tokens by a consumer.

68. (Once Amended) The computer program product of claim 58, wherein transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of a frequency of usage of product discounts by a consumer.

69. (Once Amended) The computer program product of claim 58, wherein identifying

said token data comprises identifying said token data by scanning a token having said token data therein.

70. The computer program product of claim 58, wherein said computer network comprises one of an intranet and the Internet.

X. 37 CFR 1.192(c)(9) - Appendix II List of Attachments

Attachment Number	Description of Attachment
1	A copy of the ten page printout of www.archive.org/about/about.php .
2	A copy of the five page printout of www.archive.org .
3	A copy of the two page printout of pages.alexa.com/company/index.html?p=Dest_W_t_40_B1 .
4	A copy of the printout of the WAYBACK MACHINE'S search result for http://performancebike.com conducted on November 27, 2002.
5	A copy of the printout from www.verisign.com/corporate/news/apr_19980107.html describing Network Solutions, Inc.
6	A copy of www.wired.com/news/politics/0,1238,31551,00.html .
7	A copy of the printout from www.netsol.com 's WHOIS search engine for www.PerformanceBike.com .
8	A copy of the printout of 8 pages of the PerformanceBike.com web site from 1997, as stored in the WAYBACK MACHINE.
9	Declaration of Examiner Stephen Gravini.

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